



26 JUL 2002

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In re Application of HAMMOND et al : DECISION ON PETITION
U.S. Application No.: 09/807,608 :
Int. Application No.: PCT/AU99/00891 :
Int. Filing Date: 15 October 1999 : UNDER 37 CFR 1.47(a)
Priority Date: 16 October 1998 :
Attorney Docket No.: Q63675 :
For: A PARKING MANAGEMENT SYSTEM :

This is in response to applicant's "Renewed Petition Under 37 C.F.R. §1.47(a)" filed 11 July 2002.

BACKGROUND

On 15 October 1999, applicant filed international application PCT/AU99/00891, which claimed priority of an earlier Australia application filed 16 October 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 May 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 April 2001.

On 16 April 2001, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 23 July 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 26 December 2001, applicant filed a petition under 37 CFR 1.47(a) along with a declaration executed by three of the joint inventors and not executed by inventor Andrew Gockel.

On 11 January 2002, this Office mailed a decision dismissing the 26 December 2001 petition on grounds that applicant had not provided sufficient proof of the inventor's purported refusal to sign.

On 11 July 2002, applicant filed the present renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Gockel for signature. Specifically, the affidavit of Michael Lindsay Craig states that the application papers were sent to Gockel on 22 April 2002 (see Craig's 11 July 2002 affidavit and Exhibit H). Gockel's receipt of the 22 April 2002 letter is confirmed by his electronic mail reply (see Exhibit I).

Furthermore, applicant has adequately demonstrated that Gockel refuses to sign. Gockel stated in an electronic mail message dated 23 May 2002 that he has not indicated his refusal to sign (see Exhibit L). In response to the 23 May 2002 message, applicant sent another letter on 24 May 2002 to Gockel requesting the return of the signed application papers (see Exhibit M). Craig's affidavit states that Craig was told over the telephone that Gockel had received the 24 May 2002 letter (see Exhibit M). The 24 May 2002 letter requested a reply by 31 May 2002, and as of the date the renewed petition was filed, no response from Gockel had been received. Thus, Gockel's repeated failure to supply the information requested of him constitutes a refusal to cooperate. Therefore, it can be concluded with reasonable certainty that Gockel refuses to join in the application.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

This application has an international filing date of 15 October 1999 and a date under 35 U.S.C. 371(c) of 26 December 2001.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.


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